

In re application of:

BUSH *et al.*

Appl. No. 09/972,913

Filed: October 10, 2001

For: Use of Clioquinol for the Therapy
of Alzheimer's Disease

Confirmation No. 5681

Art Unit: 1615

Examiner: *To be assigned*

Atty. Docket: 0609.4540003/JAG/FRC

Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a)

Commissioner for Patents
Washington, D.C. 20231

COPY

Sir:

In reply to the Decision Refusing Status Under 37 C.F.R. § 1.47(a) dated February 11, 2002, (PTO Prosecution File Wrapper Paper No. 3), the period for reply having been extended five (5) months by petition and payment of the appropriate fee, Applicants submit the following Request for Reconsideration.

The Decision Refusing Status Under 37 C.F.R. § 1.47(a) indicates that Applicants have met all of the requirements under 37 C.F.R. § 1.47(a) except for the requirement that a declaration which complies with 37 C.F.R. § 1.63 be submitted with the "Rule 47" petition. See Paper No. 3, page 2, lines 14-16. More specifically, it is asserted that the declaration that was submitted to inventor Xilinas "fails to list the residence, citizenship, or post office address of inventor Cherny." See Paper No. 3, page 2, lines 17-19. It is further indicated that, upon renewed petition, Applicants should either provide the signature of the non-signing inventor (Xilinas), or provide a showing that a declaration which complies with 37 C.F.R. § 1.63 has been submitted to the non-signing inventor for his review. See Paper No. 3, page 2, lines 20-22.

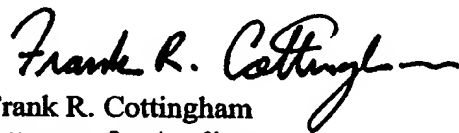
Accordingly, submitted herewith is an Affidavit signed by Frank R. Cottingham, attorney for Applicants, asserting that a declaration which complies with 37 C.F.R. § 1.63 has been submitted to Dr. Xilinas for his review. Applicants believe that the facts stated in the attached Affidavit, along with its Exhibits, establish that a Declaration for Patent Application which complies with 37 C.F.R. § 1.63 was presented to Dr. Xilinas for his review and that a *bona fide* attempt was made to obtain his signature thereon.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Applicants believe that a full and complete reply has been made to the outstanding Decision Refusing Status Under 37 C.F.R. § 1.47(a). Applicants therefore respectfully request that the Decision Refusing Status be reconsidered and that Applicants' Petition Under 37 C.F.R. § 1.47(a) be granted.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Frank R. Cottingham
Attorney for Applicants
Registration No. 50,437

Date: 9/11/02

1100 New York Avenue, N.W.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

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**Affidavit in Support of Request for Reconsideration of Petition
Under 37 C.F.R. § 1.47(a)**

Commissioner for Patents
Washington, D.C. 20231

COPY

Sir:

I, the undersigned, Frank R. Cottingham, hereby declare and state that:

1. I am attorney for The General Hospital Corporation, the assignee of the above-captioned patent application.
2. I have read and understand 37 C.F.R. §§ 10.18(b) and (c).
3. Michel¹ Xilinas has been named as an inventor on the above-captioned patent application.
4. On July 25, 2002, the following items were sent by Federal Express to Dr. Xilinas at his then last-known address, 15 Atalante, 145 63 Kisifia, Greece:
 - (a) Cover letter (copy included herewith as Exhibit A);
 - (b) Copy of the above-captioned patent application (copy included herewith as Exhibit B);

¹At the time the above-captioned application was filed, it was believed that the correct spelling of inventor Xilinas' first name was "Mikhal." It was subsequently discovered that the correct spelling of his first name is Michel.

- (c) Copy of the Preliminary Amendment that was filed with the application (copy included herewith as Exhibit C);
- (d) Declaration for Patent Application that complies with 37 C.F.R. § 1.63 (copy included herewith as Exhibit D); and
- (e) Copy of 37 C.F.R. §§ 10.18(b) and (c) (copy included herewith as Exhibit E).

5. On August 8, 2002, a Federal Express tracking report was obtained by the undersigned indicating that, on July 31, 2002, the Federal Express package containing the above-listed items was successfully delivered and signed for. A copy of the tracking report is included herewith as Exhibit F.

6. On August 8, 2002, an electronic mail (e-mail) message purportedly sent by Dr. Xilinas was received by the undersigned. The message indicated that Dr. Xilinas had received the Federal Express package of July 25, 2002. The message also indicated that Dr. Xilinas would be sending the documents in the Federal Express package to Dr. Xilinas' lawyer, Mr. Georgopoulos, but that Mr. Georgopoulos' law office was closed for the August vacations. The message further stated that Dr. Xilinas is a French citizen, that the correct spelling of his first name is Michel (not Mikhal) and that he is a resident of Larnaca, Cyprus. A copy of the August 8, 2002 e-mail message is included herewith as Exhibit G.

7. On September 6, 2002, a second e-mail message purportedly sent by Dr. Xilinas was received by the undersigned. Attached to the e-mail message was a letter from Dimitri M. Georgopoulos addressed to the undersigned. In the letter, Mr. Georgopoulos requested that I provide him (Mr. Georgopoulos) with "the necessary background information" including information regarding the "pending legal case between Prana, MGH

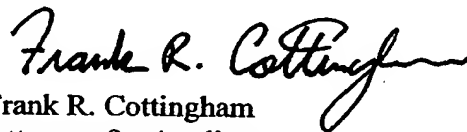
and P.N. Gerolymatos." A copy of the September 6, 2002 e-mail message, including the attachment from Mr. Georgopoulos, is included herewith as Exhibit H.

8. In response to Mr. Georgopoulos' request for information, copies of the complaint and answer that were filed in the litigation between Prana Biotechnology, Ltd *et al.* and P.N. Gerolymatos S.A., were sent to Mr. Georgopoulos via facsimile on September 10, 2002. A copy of the documents that were sent via facsimile to Mr. Georgopoulos is included herewith as Exhibit I.

9. As of the date indicated below, no further communication has been received from either Dr. Xilinas or Mr. Georgopoulos.

Respectfully submitted,

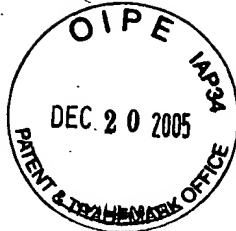
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



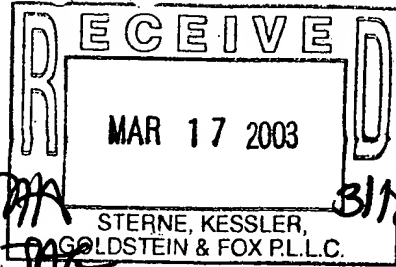
Frank R. Cottingham
Attorney for Applicants
Registration No. 50,437

Date: 9/11/02

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Paper No. 8

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W., SUITE 600
WASHINGTON DC 20005-3934

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MAR 14 2003

OFFICE OF PETITIONS

In re Application of
Ashley I. Bush, Rudolph E. Tanzi, Mikhal Xilinas, and
Robert Cherny
Application No. 09/972,913
Filed: October 10, 2001
Attorney Docket No. 0609.4540003
Title: USE OF CLIOQUINOL FOR THE THERAPY
OF ALZHEIMER'S DISEASE

DECISION ON PETITION

This is a decision on the renewed petition pursuant to 37 C.F.R. §1.47(a)¹, filed on September 11, 2002², and the petition under 37 C.F.R. §1.137(b), filed on September 24, 2002.

The petition under 37 C.F.R. §1.47(a) is **GRANTED**.

The petition under 37 C.F.R. §1.137(b), which is properly treated as a petition under 37 C.F.R. §1.181 to withdraw the holding of abandonment, is **GRANTED**.

The original petition was filed along with the above-identified application on October 10, 2001³. This original petition was dismissed via a decision mailed on February 11, 2002, for failure to submit an oath or declaration which complied with the requirements of 37 C.F.R. §1.63.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (5) a declaration which complies with 37 CFR §1.63.

² In order to make this reply timely, petitioner has filed a petition for a five-month extension of time.

³ The declaration submitted upon filing contains the signatures of three of the four joint inventors, with inventor Xilinas being the non-signing inventor.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the addresses given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

Regarding the petition under 37 C.F.R. §1.181, this petition is granted. On September 16, 2002, the Office mailed a Notice of Abandonment, indicating that the application had gone abandoned for failure to submit a timely reply to the Notice to File Missing Parts, mailed on February 11, 2002⁴. On September 11, 2002, petitioner obtained a five-month extension of time. Accordingly, the renewed petition under 37 C.F.R. §1.47(a) was timely filed. Hence, the Notice of Abandonment is hereby **WITHDRAWN**, as it was sent in error.

After this decision is mailed, the application will be forwarded to Technology Center 1600 for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011.



Paul Shanowski
Attorney
Office of Petitions
United States Patent and Trademark Office

⁴ The petition fee of \$640.00 has been refunded to petitioner's Deposit Account, as authorized in the petition.